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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,931	05/30/2006	Riccardo Carlo Giolitti	GIOLITTI ET AL-1 PCT	8734
25889	7590	10/04/2007	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			CECIL, TERRY K	
		ART UNIT	PAPER NUMBER	
		1723		
		MAIL DATE	DELIVERY MODE	
		10/04/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/580,931	GIOLITTI ET AL.
<b>Examiner</b>	<b>Art Unit</b>	
Mr. Terry K. Cecil	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 02 August 2006.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-7 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-7 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 30 May 2006 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date *two*.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: .

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following:
  - The abstract of the disclosure is objected to because (i) the abstract should be only one paragraph; and (ii) the first sentence is unclear and seems to be a literal translation from a foreign language. See MPEP § 608.01(b).
  - Since claim language is dynamic changing through the prosecution, references to specific claims numbers (e.g. "claim 1" in the first and sixth paragraphs) in the specification should be removed.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Applicant's disclosure does not properly describe the separating/retaining device. The specification states only that it is a protective device 9 that ensures only fuel and no water can enter the connecting line. What is the device? What structure enables only fuel to pass therethrough and not water? How does the device function? These unanswered questions

raise doubt as to possession of the claimed invention at the time of filing.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because of the following reasons:

- Because the phrases “an area of the filter housing”; “an upper area of the water collection chamber”; and “an area of the fuel delivery line” all appear in claim 1, the antecedent basis for “said area” near the end of the claim is unclear.
- Claims 2-7 are rejected since they suffer the same defects as the claims from which they depend.

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

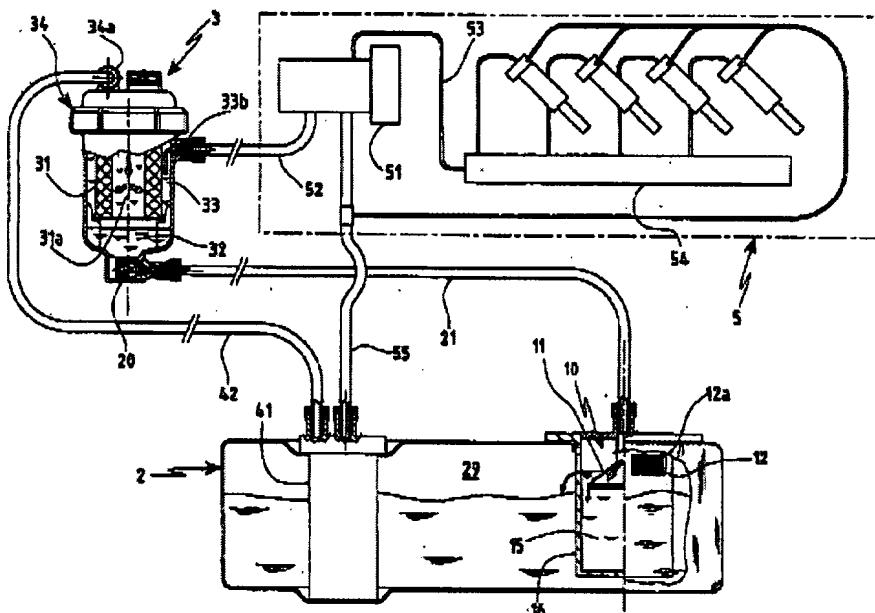
A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by International Application (WO 03/067068), hereinafter '068.



‘068 teaches a fuel filter 3 including a chamber 32 for separated water that is drained into a water collection chamber 15. The upper area of which is provided with an opening (figure 3) for fuel to return to the tank (this is considered downstream of the filter because of line 55) [as in claim 1]. A delivery pump is provided 51 [as in claim 2]. A filter 12 is connected upstream of the opening from the upper area of the water collection chamber [as in claim 7].

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

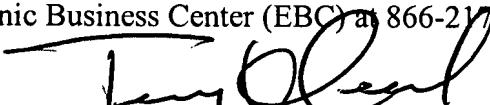
9. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over '068 in view of the German reference (DE 3600669 A), hereinafter '669|. '669 teaches a venturi 15 for drawing fluids and acting as a pump. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the venturi of '669 in the invention of '068 (e.g. in the return line 55 integrated with openings in the water collection chamber) in order to have the benefit of pumping the fuel from the upper portion of the water collection chamber and into the fuel tank.

10. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over '068 in view of WO 01/33069 A1, hereinafter '069. '069 teaches a level sensor 21 in a water separation chamber. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the water level sensor of '069 in the water collection chamber 15 of '068, since '069 teaches the benefit of an alarm 57 for indicating when the water separation chamber is full (and not draining indicating a problem in the system). As for in figure 1, '069 also teaches a drain (faucet) in the bottom of the water collection chamber 25. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to

have the drain of '069 in the water collection chamber 15 of '068, since such would provide the benefit of emptying the water when full.

11. Contact Information:

- Examiner Mr. Terry K. Cecil can be reached at (571) 272-1138 at the Carlisle campus in Alexandria, Virginia for any inquiries concerning this communication or earlier communications from the examiner. Note that the examiner is on the increased flextime schedule but can normally be found in the office during the hours of 8:30a to 4:30p, on at least four days during the week M-F.
- David R. Sample, the examiner's supervisor can be reached on 571-272-1376, if attempts to reach the examiner are unsuccessful.
- The Fax number for this art unit for official faxes is (571) 273-8300.
- Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mr. Terry K. Cecil  
Primary Examiner  
Art Unit 1723

TKC  
September 29, 2007